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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/008,484 01/16/98 YAMANA

EXAMINER

IM11/0122

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ART UNIT	PAPER NUMBER
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NUTTER, N

4

DATE MAILED:

1/11

01/22/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-13 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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DETAILED ACTION

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of claims 1, 5 and 10 with regards to the monomeric constituents is deemed to be functional at the point of novelty. For examples, the recitation of "a monomer having a fluoroalkyl group", "a monomer containing no fluorine", "a crosslinking monomer" and other statements and terms including "derived" fail to adequately teach what is actually being claimed as applicants' inventive subject matter. The proper metes and bounds of the claims cannot be clearly ascertained without an undue burden of experimentation on the part of the practitioner. In particular, the use of negative language to describe a component, such as "containing no fluorine" is deemed to be inappropriate.

Further, the use of terms such as "fluoroalkyl", "alkylene", "lower alkyl", "aromatic", "alicyclic", "alkyl" and "aryl", as recited in the claims, in particular, claim 4, is deemed to be

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unacceptable claim language. Note the holdings to In re Sus et al 135 USPQ 301, In re Lund et al 153 USPQ 625 and In re Cavalitto et al 134 USPQ 370 wherein these and similar terms, recited without specific limitations, have been deemed to be unacceptable.

Claim 4 is not clear at (line 19) in the recitation of "and is X is -R -".

In claim 9 (line 25), the article "a" should agree in number with "agents", which it modifies.

In claim 11, the term "mainly" is unacceptable.

Claims 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 12 and 13 are drawn to a textile material, whereas claims 1-11 from which they depend are drawn to a stainproofing agent..

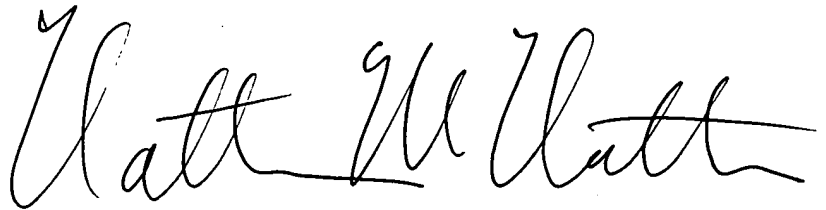
The references to Dessaint et al and Ito et al are cited of interest.

The Dessaint et al patent teaches the production of a fluoroalkyl polymer essentially identical to the (A) copolymer as recited herein, employed as a stainproofing agent, which may be used in conjunction with an acrylic copolymer. Note column 4 (line 16) to column 6 (line 59) for the fluoroalkyl copolymer. Further, note column 8 (lines 31 et seq) for the use of the acrylic copolymer. No teaching or suggestion is presented for the inclusion of the urethane copolymer as claimed herein.

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In Ito et al, note column 3 (line 41) to column 6 (line 4) for the production of a fluoroalkyl copolymer which may incorporate an isocyanate constituent. The patent fails to teach the production of a urethane bond or the subsequent inclusion of the patented compound with other stainproofing ingredients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is (703) -308-2443.

A handwritten signature in cursive script, appearing to read "Nathan M. Nutter".

NATHAN M. NUTTER
PRIMARY EXAMINER
GROUP 4200 (711)

nmn

January 11, 1999